



Attorney Docket # 33900-161PUS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

In re Application of

Guy FONTANILLE et al.

Serial No.: 10/507,022

Filed: August 18, 2005

For: Rotationally retractable propeller

Examiner: S. D. Basinger
Group Art: 3617

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April 24, 2006
(Date of Deposit)

Edward M. Weisz

Name of applicant, assignee or Registered Representative

Signature

April 24, 2006
Date of Signature

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

COMMUNICATION

SIR:

Enclosed please find an English translation of the International Preliminary Examination Report issued in connection with the corresponding PCT application. Please make this a part of the file.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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By

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PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

Translation

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing
(day/month/year)

Applicant's or agent's file reference

H52103 C5/MD

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/FR2004/000743

International filing date (day/month/year)

25.03.2004

Priority date (day/month/year)

09.04.2003

International Patent Classification (IPC) or both national classification and IPC

Applicant

MAX POWER

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☒ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/EP

Authorized officer

Facsimile No.

Telephone No.

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Box No. I Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
☐ This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material
☐ a sequence listing
☐ table(s) related to the sequence listing
 - b. format of material
☐ in written format
☐ in computer readable form
 - c. time of filing/furnishing
☐ contained in the international application as filed.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

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Box No. II

Priority

1. ☒ The following document has not yet been furnished:

☒ copy of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(a)).

☐ translation of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date is the claimed priority date.

2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43bis.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

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Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	1-13	YES
	Claims		NO
Inventive step (IS)	Claims	10	YES
	Claims	1-9, 11-13	NO
Industrial applicability (IA)	Claims	1-13	YES
	Claims		NO

2. Citations and explanations:

Reference is made to the following documents in the present notification:

D1: WO 98/30440 A (ULSTEIN PROPELLER ;GAREN RUNE (NO)) 16 July 1998 (1998-07-16)

D2: EP-A-0 612 658 (YAMAHA MOTOR CO LTD) 31 August 1994 (1994-08-31)

1.0 INDEPENDENT CLAIM 1

The present application fails to comply with the requirements of PCT Article 33(1), since the subject matter of claim 1 does not meet the requirements of inventive step defined by PCT Article 33(3).

Document D1, which is considered the closest prior art to claim 1, describes (the references between parentheses apply to this document):

A retractable propeller for a floating or submersible device comprising a propeller unit (1) comprising a rigid structure (2) coupled to a cylindrical turbine, said rigid structure containing or capable of containing a motor, said

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citations and explanations supporting such statement

motor being capable of rotationally driving at least one helix inside said turbine, using at least one shaft that rotates between said motor and said helix, said propeller unit (1) may be displaced using displacement means between a retracted rest position (S) inside the hull and a spread-out propulsion position (O^N) wherein the helix is submerged below the hull, wherein said displacement means enable said propeller unit to be displaced between said retracted (S) and spread-out (O^N) positions according to a uniform circular movement of said propeller unit in relation to a centre of rotation (A).

Consequently, the subject matter of claim 1 differs from the instructions of D1 in that there is (preferably) a plate to close the hull placed below the turbine and coupled to it (a1), and in that the centre of rotation is located notably at the level of the hull or below said hull (a2). Since the two different features mentioned are not interactive, these features are merely a juxtaposition of features instead of a combination of features.

The problems that the present invention is intended to solve can thus be considered to be that of (a1) how to close the hull when the cylindrical turbine is retracted to improve water flow, and (a2) how to change the centre of rotation of the propeller unit to reduce the space the retracted propeller unit takes up.

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Reasoned statement under Rule 43bis 1(a)(i) with regard to novelty, inventive step or industrial applicability;
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The solutions (a1, a2) proposed in claim 1 of the present application are not considered inventive (PCT Article 33(3)) for the following reasons:

(a1) According to the description given in D2, the plate that closes (72 in D2) the hull has the same advantages as those mentioned in the present application. Therefore, including this feature in the retractable propeller described in document D1 constitutes a normal step taken by a person skilled in the art to solve the stated problem.

(a2) The feature of placing the centre of rotation at the level of the hull or below said hull is merely one of a plurality of obvious options that a person skilled in the art may choose, depending on the circumstances, to solve the stated problem without involving an inventive step. Persons skilled in the art are always seeking to reduce the space taken up by objects fixed in a boat.

Consequently, the features described in documents D1 and D2 would be combined by a person skilled in the art, without demonstrating inventiveness, to solve the stated problem. Therefore, the solution proposed in independent claim 1 cannot be considered as involving an inventive step (PCT Article 33(3)).

2.0 DEPENDENT CLAIMS 2-9, 11-13

The claims do not contain any features which, combined with the features of any one of the claims to which they refer, meet the requirements

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of the PCT of novelty and inventive step (PCT
Article 33(2) and (3)).